



APR 06/23/03
365
#9

Docket No.: M4065.0467/P467
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Amy R. Griffin

Application No.: 09/893,619

Group Art Unit: 3652

Filed: June 29, 2001

Examiner: C. Fox

For: LIFT AND ALIGN TABLE

REQUEST FOR RECONSIDERATION

RECEIVED

JUN 18 2003

GROUP 3600

Box AF
Commissioner for Patents
Washington, DC 20231

Dear Sir:

In response to the Office Action dated March 12, 2003 (Paper No. 8), finally rejecting claims 1-4, 6-13, 17-28, 31-35 and 39-46, please reconsider the pending claims in light of the following remarks. In the Office Action, rejections of dependent claims are sometimes discussed before the rejections of their base claims. These remarks are set up in claim order.

Claims 1 and 8-11 stand rejected under 35 U.S.C. 102 as being anticipated by Beach. Reconsideration is requested because Beach fails to teach or suggest several limitations of claim 1.

Initially, claim 1 recites a "sliding mechanism comprising a block and a lead screw for moving said block." The moving sliding block is shown, for example, as element 198 in Figure 7 of the specification. In a preferred embodiment, the block 198 moves linearly in response to rotation of lead screw 196. Specification, page 11, lines 9-15. The Office Action proposes that Beach teaches a "block (111)" which corresponds to the

claimed moving block. Office Action, page 2. However, element 111 of Beach is opposite to the recited movable block. Element 111 in Beach is nut which is “anchored to an end beam ... of the upper dolly frame.” Column 7, lines 40-43. Thus, element 111 in Beach has nothing in common with the claimed moving block because it does not move. For at least this reason, Beach does not anticipate claim 1.

Further, claim 1 recites a “third section disposed over said sliding mechanism and attached to said block.” This is an important feature of the claimed invention. The specification discloses, for example, an upper plate 40 which is mounted to the sliding mechanism. Specification, page 11, lines 16-25.

Beach fails to teach or suggest this limitation. The Office Action asserts that Beach discloses a sliding mechanism “comprising a block (111) and a lead screw (110),” and a “third section (13) [is] disposed over said sliding mechanism.” Office Action, page 2. There is no basis for this assertion. In Beach, the “third section (13)” is not “disposed over said sliding mechanism” -- it is the sliding mechanism. Elements 111 and 110 in Beach are part of the assembly 13. See column 7, lines 10-50 and Figure 2. The assembly 13 cannot be the claimed “sliding mechanism” and at the same time a “third section disposed over said sliding mechanism.” For this additional reason, Beach fails to anticipate claim 1.

Claims 8-11 depend from claim 1 and contain all of the limitations of claim 1. Claims 8-11 should be allowed for at least the same reasons as for allowance of claim 1.

Claims 2-4 and 7, 13, 17-23, 26-28, 31-33 and 35 stand rejected under 35 U.S.C. 103 as being unpatentable over Beach as applied to claim 1 above, further in view of Mills. Reconsideration is respectfully requested for the following reasons.

Claim 1 is allowable over Beach as discussed above. Mills adds nothing to remedy the deficiencies of Beach. Claims 2-4 and 7 depend from claim 1 and contain all of the limitations of claim 1, and should be allowed together with claim 1.

Further, no motivation exists to combine Beach and Mills. The Office Action states that it would not have been obvious to combine Mills' "series of jack screws (64)" and "series of pneumatic lifts (54, 120)" with Beach "in order to allow the apparatus to align the object being lifted with its intended receiver in a manner that minimizes the chance of damage to the object while it is being mounted." Office Action, page 3. However, no motivation exists for such a combination.

There is no suggestion or motivation in the references themselves to make the proposed combination, and the Office Action does not assert that any exists. Rather, the Office Action apparently relies on knowledge in the art for supplying the required motivation, which is to "minimize[] the chance of damage." There is simply no support for this assertion because the mechanism of Beach is self sufficient. Beach discloses a hydraulic scissor lift assembly 12 which is described in detail in column 4, line 30 through column 7, line 10. The scissor lift 12 has main rams 77, booster rams 90, a pump 96 with check valves to control hydraulic flow rates, and a safety means for preventing unwanted or accidental movement of the frame. Column 5, line 37 through column 6, line 69. There are no shortcomings or problems identified in Beach with respect to its lift mechanism, nor did the Office Action point to any knowledge in the art that would suggest any shortcoming. Thus, there is no motivation or reason to add to Beach's lift assembly an extra "series of jack screws" or a "series of pneumatic lifts." Such a "modification" would be unnecessary and impractical in Beach.

The only reason behind the proposed combination is the Applicant's disclosure. The Office Action uses the claimed invention as an instruction manual to pick and choose among features in Beach and Mills, and then relies on "skill in the art" for motivation to propose an unnecessary modification. To avoid this very result the Federal Circuit has stated that "[r]arely ... will the skill in the art component operate to supply missing knowledge of the prior art to reach an obviousness judgment." *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). Thus, the combination proposed by the Office Action is improper, providing added reasons why claims 2-4 and 7 should be allowed.

Claim 6 stands rejected under 35 U.S.C. 103 as being unpatentable over Beach. Claim 6 depends from claim 1 and should be allowed for the same reasons as claim 1. Claim 6 also recites that the “sliding mechanism further comprises slider blocks having slide rails.” The Office Action admits that Beach does not teach this limitation, but simply asserts that it would have been obvious “that the wheels and rails taught by Beach perform the equivalent function and would result in the same expected results.” Office Action, page 6. The wheels and rails of Beach have nothing to do with the claimed sliding mechanism, nor does the Office Action endeavor to explain why Beach would be modified in accordance with claim 6. Suffice it to say that the Office Action fails to establish a *prima facie* case for obviousness (*See* MPEP § 2142) in making this rejection.

Claim 12 stands rejected under 35 U.S.C. 103 as being unpatentable over Beach as applied to claim 1 above, and further in view of Ueda. Claim 1 is allowable over Beach as explained above, and claim 12 which depends from claim 1 is likewise allowable. Further, claim 12 recites a “second sliding mechanism over said third section ... and a fourth section disposed over said second sliding mechanism.” The Office Action asserts only that it would have been obvious “to provide the directional capabilities taught by Ueda to the apparatus taught by Beach.” Office Action, page 7. Claim 12 does not recite “directional capabilities;” it recites a second sliding mechanism and a fourth section over the second sliding mechanism. The Office Action does not even assert that the alleged combination of references teaches all of the elements of claim 12, and thus again fails to establish a *prima facie* case of obviousness.

Claim 13 recites a “lifting mechanism comprising a jacking screw mechanism and a gas cylinder assembly.” The Office Action asserts that it would have been obvious to combine Beach and Mills to meet this limitation. As discussed above, the proposed combination of Beach and Mills is an impermissible hindsight reconstruction of the claimed invention because no motivation or reasons exist to combine the references. In addition, even if Beach and Mills were properly combinable (and they are not), the proposed combination would not teach or suggest all the claim limitations. For example, claim 13 recites a “first sliding mechanism disposed between said first section and said second

section.” As discussed above with respect to claim 1, Beach fails to teach or suggest this limitation, and Mills adds nothing to remedy this deficiency. Claim 13 is thus allowable for at least these reasons.

Claims 17-23 depend from claim 13 and should be allowed for at least the reasons for allowance of claim 13, and also because the combinations recited in these dependent claims are neither taught nor suggested by the references. For example, claim 17 recites that the sliding mechanism comprises a “lead screw and block.”

Claim 18 stands rejected under 35 U.S.C. 103 as being unpatentable over Beach as applied to claim 1 above, and further in view of Mills. Claim 18 is allowable because it depends from claim 1, which, as explained above is not anticipated by Beach. Further, as discussed above, Beach and Mills are not properly combinable, providing added reasons for the allowance of claim 18.

Claim 24 stands rejected under 35 U.S.C. 103 as being unpatentable over Beach in view of Mills as applied to claim 13, and further in view of Ueda. Claim 13 is allowable over Beach in view of Mills, for the reasons given above. Claim 24 depends from claim 13 and is allowable for at least the same reasons. Further, claim 24 recites a “third section containing a second sliding mechanism disposed over said second section,” which is not rendered obvious by the teachings of the references. The Office Action relies on Ueda’s teaching of “directional capabilities” for rejecting claim 24, but does not address the specific limitations of claim 24 quoted above. Accordingly, a prima facie case of obviousness has not been established.

Claim 25 stands rejected under 35 U.S.C. 103 as being unpatentable over Beach. Claim 25 recites an apparatus having a “mechanism for sliding an object ... wherein said mechanism for sliding comprises a lead screw and a movable block mechanism, and slider blocks having slide rails.” The Office Action asserts that Beach discloses a “block (111) and a lead screw (110) for moving said block.” As discussed above with respect to claim 1, this is an incorrect reading of Beach because element 111 in Beach is a fixed nut rather than the claimed movable block mechanism. Further, the Office Action admits that

Beach does not teach slider blocks having slide rails, but concludes that the “wheels and rails taught by Beach perform the equivalent function.” The wheels and rails of Beach have nothing to do with the claimed sliding mechanism and certainly do not teach or suggest the limitations quoted in this paragraph. The Office Action also fails to explain how or why Beach would be modified to produce the subject matter in claim 25. The Office Action again fails to establish prima facie obviousness of the claim 25 subject matter.

Claims 26-28 and 31-33 depend from claim 25. Claims 26-28 and 31-33 contain all of the limitations of claim 25 and are allowable together with claim 25. In addition, the subject matter specifically defined by claims 26-28 and 31-33 is neither taught nor suggested by Beach in view of Mills. Moreover, such a combination is improper, as discussed above.

The Office Action further asserts that Beach “teaches” the limitations of claim 34. Office Action, page 5. Claim 34 recites a “sliding mechanism comprising a block having a transmission system for moving said block.” As discussed above with respect to claim 1, Beach fails to teach or suggest this limitation. In addition, claim 34 teaches a “lifting and lowering mechanism comprising at least four jacking screws ... [and] at least two gas cylinders ..., wherein said gas cylinders assist said jacking screws in said lifting and lowering mechanism.” The Office Action again relies on a combination of Beach and Mills to meet this claim limitation. As discussed above, Beach and Mills are not properly combinable. Claim 34 is thus also allowable for at least these additional reasons.

Claim 35 recites a method of operating a lift mechanism comprising “manually rotating an input shaft attached to jacking mechanisms and supplying a pressurized gas to gas cylinder assemblies.” The Office Action does not explain how the cited references could be combined to teach this limitation. As explained above, Beach and Mills are not properly combinable, and for this reason alone claim 35 is allowable. In addition, neither reference teaches the step of “manually rotating an input shaft” in combination with the other claim elements, providing yet additional reasons for allowance of this claim.

Claims 35, 39, 40, 41 and 45 stand rejected under 35 U.S.C. 103(a) by Beach in view of Nemoto. Reconsideration is respectfully requested.

Claim 35 recites a method of operating a lift mechanism comprising “manually rotating an input shaft attached to jacking mechanisms and supplying a pressurized gas to gas cylinder assemblies.” The Office Action does not address the limitations of claim 35 in this rejection. The Office Action admits that Beach does not teach manually rotating a shaft to operate a lift mechanism, and relies on Nemoto for this shortcoming. However, the Office Action is silent regarding the limitation of “supplying a pressurized gas to gas cylinder assemblies.” Indeed, this limitation is neither taught nor suggested by Beach or Nemoto, and claim 35 is allowable for at least this reason. Claims 39 and 40 depend from claim 35 and are allowable together with claim 35.

Claim 41 recites a method for transferring an object comprising “providing a base frame, a top frame, and a middle frame disposed between said base frame and said top frame; [and] providing a slide mechanism between [the] middle frame and [the] top frame” (emphasis added). This subject matter can be seen in Figure 1, for example, and accompanying specification which discusses an embodiment wherein a middle frame 30 is disposed between a lower frame 20 and a top frame 40. The top frame 40 is elevationally higher than the middle frame 30. In addition, a sliding mechanism 70 is provided between the middle frame 30 and the top frame 40. Beach and Nemoto, taken alone or in combination, fail to teach or suggest these quoted claim limitations.

The Office Action asserts that Beach teaches a “base section (14), [and] a middle section and a support section (60) adapted to move vertically and horizontally.” Office Action, page 8. The Office Action does not assert that Beach teaches a middle frame disposed between the base frame and the top frame. Indeed, Beach does not. Beach discloses a lower frame 10 and an upper frame 11. See Figure 1. Beach further discloses an adjuster assembly 13 which comprises components adapted for horizontal movement. Significantly, with reference to Figure 3, 4 and 5, the adjuster assembly 13 is not elevationally higher than the upper frame 11. There is no component in Beach which is

disposed between a lower and upper frame, and which has a sliding mechanism between such component and the upper frame, as recited in claim 41. Nemoto does not remedy this shortcoming.

For at least these reasons, claim 41 is allowable. Claim 45 depends from claim 41 and is allowable together with claim 41. Applicant notes that the above argument was presented in the Amendment dated January 3, 2003, and that it was not addressed in the Office Action.

Claim 43 stands rejected under 35 U.S.C. 103 as being unpatentable over Beach in view of Nemoto as applied to claim 41, further in view of Shiiba. Claim 43 depends from claim 41 and contains all of the limitations of claim 41 and is accordingly allowable for the reasons expressed for the allowance of claim 41. Shiiba adds nothing to remedy the deficiencies of the combination of Beach and Nemoto.

Claim 44 stands rejected under 35 U.S.C. 103 as being unpatentable over Beach in view of Nemoto as applied to claim 41, and further in view of Mills. Claim 44 depends from claim 41 and contains all of the limitations of claim 41. As discussed above, claim 41 is allowable over Beach in view of Nemoto, and Mills adds nothing to remedy the deficiencies of the alleged combination. Thus, claim 44 should be allowed for at least the same reasons as for allowance of claim 41. Moreover, claim 44 recites the method step of "manually rotating an input shaft attached to jacking mechanisms and supplying a pressurized gas to gas cylinder assemblies." Mills, even if properly combinable with Beach and Nemoto (and it is not), fails to teach or suggest the combination of manually rotating an input shaft attached to jacking mechanisms and supplying a pressurized gas to gas cylinder assemblies. For this additional reason, claim 44 should be allowed.

Application No.: 09/893,619

Docket No.: M4065.0467/P467

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Dated: June 12, 2003

Respectfully submitted,

By 

Thomas J. D'Amico

Registration No.: 28,371

Peter A. Veytsman

Registration No.: 45,920

DICKSTEIN SHAPIRO MORIN &

OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorneys for Applicant